



NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES		Docket Number (Optional) 104831-0002-103	
In re Application of Chang et al.			
Application Number 10/657,383		Filed September 8, 2003	
For METHOD FOR ENHANCING THE EFFECTIVENESS OF CANCER THERAPIES			
Art Unit 1623		Examiner L. C. Maier	

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1))

\$ 500.00

☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:

\$ 250.00

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

05/29/2007 EFLORES 00000028 181945

0657383

☒ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

01 JUL 2007 15:00 DA

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 18-1945. I have enclosed a duplicate copy of this sheet.

☒ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

I am the

☐ applicant /inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)


Signature

Jesse A. Fecker, Ph.D.
Typed or printed name

☒ attorney or agent of record.

Registration number 52,883

(617) 951-7633

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____

May 22, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 5-22-07

Signature:  Maura A. Gallagher

with any paper hereafter filed in this application by this firm) to our Deposit Account No. **18-1945**, under Order No. 104831-0002-103. Please direct any questions arising from this submission to the undersigned at (617) 951-7615.

Date: May 22, 2007

Customer No: 28120
Fish & Neave IP Group
Ropes & Gray LLP
One International Place
Boston, MA 02110
Phone: 617-951-7615
Fax: 617-951-7050

Respectfully Submitted,



David P. Halstead
Reg. No: 44,735

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 5-22-07 Signature: Maura A. Gallagher
Maura A. Gallagher

Docket No.: 104831-0002-103
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Chang et al.

Application No.: 10/657,383

Confirmation No.: 9375

Filed: September 8, 2003

Art Unit: 1623

For: METHOD FOR ENHANCING THE
EFFECTIVENESS OF CANCER THERAPIES

Examiner: L. C. Maier

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PETITION UNDER 37 CFR § 1.183 TO WAIVE 37 CFR § 1.48(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

05/29/2007 EFLORES 00000029 181945 10657383
02 FC:1462 400.00 DA

Dear Sir:

Assignee respectfully submits this Petition Under 37 CFR § 1.183 to Waive 37 C.F.R. § 1.48(a) in order to add David Platt as an inventor even though he has not signed a statement indicating that the error in inventorship occurred without deceptive intent on his part.

On April 20, 2007, I sent by registered mail to David Platt and his counsel, Barry Schindler of Greenberg Traurig, documents for Dr. Platt to sign and a letter requesting that Dr. Platt sign and return them to have his name added as an inventor (Exhibits A and B). On April 30, 2007, I received a letter from Mr. Schindler indicating that Dr. Platt would make a good-faith effort to review the documents and that a reply would be received by May 18, 2007 (Exhibit C). Mr. Schindler subsequently sent a letter on May 18, 2007 (Exhibit D), indicating that Dr. Platt refuses to sign the documents. The basis for Dr. Platt's refusal is his belief that Yan Chang is not an inventor (Exhibit D, page 5, last full paragraph). In addition, Dr. Platt's counsel has erroneously interpreted the Declaration of Added Inventor under 37 CFR § 1.48(a) as requiring Dr. Platt to attest to the state of mind of others than himself (Exhibit D, page 6, second

paragraph). Nowhere in Exhibit **D**, however, does Dr. Platt indicate that he had deceptive intent in not originally being named an inventor of the claimed invention. Indeed, it would be quite surprising if he had such deceptive intent, as his employment with GlycoGenesys, Inc. had been terminated over a year before the earliest priority date of the present application, and he was not involved in the preparation or filing of the this application, as will be further detailed below.

Dr. Platt's refusal to sign documents for this application continues his pattern of refusing to sign documents for applications that were originally assigned to GlycoGenesys, Inc. Described below are the facts surrounding Dr. Platt's refusal to sign documents for Application No. 95/000,074, which is an *inter partes* reexamination of the patent issuing from the parent of the instant application. The claims pending in Application No. 95/000,074 at the time Dr. Platt was requested to sign documents and the claims pending in the instant application are directed to similar subject matter.

On December 8, 2005, I sent by registered mail to Requester's counsel of record in the reexamination proceeding, Stephen Gaudet, as well as to counsel I understand to represent Requester in other matters, Jonathan Guest, documents for Dr. Platt to sign and a letter requesting that Dr. Platt sign and return them to have his name added as an inventor (Exhibits **E** and **F**). On December 15, 2005, I received a call from Jonathan Guest indicating that Dr. Platt was unwilling to sign the documents. I spoke again with Mr. Guest on December 19, 2005, and was told that Dr. Platt was still unwilling to sign the documents.

Dr. Platt has previously submitted a declaration on Requester's behalf in the reexamination proceeding (Exhibit **G**). At paragraph 8, this document states that Dr. Platt conceived of the idea to combine modified citrus pectin with interferon. The declarations of Raphael Nir (Exhibit **H**, see paragraphs 1-5) and Vodek Sasak (Exhibit **I**, see paragraph 4) corroborate Dr. Platt's statements. Patentee is relying on this experiment in the reexamination proceeding as indicative of conception and reduction to practice of the claimed invention.

Shortly after the experiment was concluded, Patentee terminated Dr. Platt's employment (Exhibit **J**). It was over a year later that the priority document to the application under reexamination was filed; Dr. Platt was not consulted when the inventorship for this application was determined (Exhibits **K** and **L**). Accordingly, Dr. Platt cannot have had deceptive intent in his omission as inventor.

Applicants further wish to point out that as recently as April 18, 2003, Dr. Platt apparently believed that he should be named as an inventor of the parent to the present application, published as 20030013681 (Exhibit M). Although at that time I was unaware of any information that would support this claim to inventorship, I have reached the conclusion that Dr. Platt did in fact contribute to the conception of the presently claimed invention based on information that has more recently been made available to me.

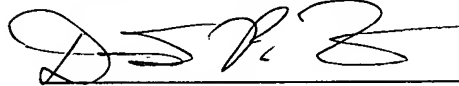
Assignee submits that it would be unjust to prevent Assignee from adding Dr. Platt as an inventor merely because Dr. Platt refuses to sign a document stating that the error in inventorship arose without deceptive intent on his part. The record shows both that Dr. Platt has a history of being uncooperative if not actually antagonistic towards Assignee's predecessor and that Dr. Platt himself admits to conceiving of treating cancer with a combination of modified citrus pectin and interferon. Furthermore, the record also shows that the omission of Dr. Platt as an inventor cannot have been due to any deceptive intent on his part, as he had no role in the preparation or filing of the application and his employment had been terminated by Assignee's predecessor long before the earliest priority application was filed. Lastly, any rights Dr. Platt may have had in the subject patent are assigned to Assignee through a chain of title beginning with Dr. Platt's employment agreement with Assignee's predecessor (Exhibit N), which is being separately recorded herewith, the Chapter 7 Trustee of Glycogenesis, Inc. to Marlborough Research and Development, Inc. (reel 018777, frame 0643), Marlborough Research and Development, Inc. to Prospect Pharmaceuticals, Inc. (reel 018917, frame 0374) and Prospect Pharmaceuticals, Inc. to Prospect Therapeutics, Inc. (reel 018917, frame 0395). Accordingly, Assignee requests that David Platt be added as an inventor even though he refuses to sign the statement required by 37 C.F.R. § 1.48(a).

The Commissioner is hereby authorized to charge the fee of \$400.00 pursuant to 37 CFR 1.17(f) to our Deposit Account **18-1945**. The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. **18-1945**,

under Order No. 104831-0002-103. Please direct any questions arising from this submission to the undersigned at (617) 951-7615.

Respectfully Submitted,

Date: May 22, 2007



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